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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,923	06/26/2001	Bret P. O'Rourke	MS1-655US	3843

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EXAMINER

GODDARD, BRIAN D

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 07/30/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/892,923

Applicant(s)

O'ROURKE ET AL.

Examiner

Brian Goddard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Claim Objections

1. Claim 42 is objected to because of the following informalities: Claim 42 includes two separate sentences, the second sentence being a close duplicate of the first. As the format of a claim is limited to a single sentence, one of these sentences must be removed. In the interest of compact prosecution, the examiner ignores the second sentence of claim 42 completely.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1 and 4-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In particular, the claims recite algorithmic method steps (a computer program per se) that are not necessarily embodied on a computer or any other physical medium, and therefore do not fall into any of the statutory categories of invention. See MPEP § 2106.

3. To expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2, 7, 22-23, 28-29 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "the computer" in the last line of the claim. There is insufficient antecedent basis for this limitation in the claim. In the interest of compact prosecution, the examiner ignores the final limitation of the claim, "that is operatively coupled to the computer."

Claim 7 recites the limitation "the server" in the first line of the claim. There is insufficient antecedent basis for this limitation in the claim. In the interest of compact prosecution, the examiner ignores "the server and".

Claims 22 and 23 each recite the limitation "the second playlist" in the last line of the claim. There is insufficient antecedent basis for this limitation in these claims. In the interest of compact prosecution, the examiner assumes that "the second playlist" refers to the "canonical playlist" from claim 20.

Claim 28 recites the limitation "the second playlist" in the fifth and seventh lines of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 29 is dependent upon claim 28, and recites the limitation "the second playlist" as well. Thus, claim 29 is rejected on the same basis as claim 28. In the

interest of compact prosecution, the examiner assumes that "the second playlist" refers to the "canonical playlist" from claim 20.

Claim 34 recites the limitation "the server" in the first line of the claim. There is insufficient antecedent basis for this limitation in the claim. In the interest of compact prosecution, the examiner ignores "the server and".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4, 6-7, 20-21, 23, 25, 30-34 and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. US 2002/0138844 to Otenasek et al.

Referring to claim 1, Otenasek discloses a system and method for managing streaming media content as claimed. See Figures 1-3 and the corresponding portions of Otenasek's specification for this disclosure. In particular, Otenasek teaches "a method [See Fig. 3] for managing streaming media content [digital audio/video], the method comprising:

accessing [Step 100] a first playlist [multimedia file (video)] that has a non-canonical data format ['any compressed video file type' (See paragraph 0031)];

providing a plurality of translators [COM functions for encoding to standard format] that translate playlists [See paragraph 0031] from a plurality of different non-canonical formats ['any compressed video file type' (See paragraph 0031)] to a canonical format [any encoding standard, AVI format in preferred embodiment];

calling [Step 200] one of the translators to translate the first playlist into the canonical format, forming a second playlist [AVI file] in the canonical format; and

retrieving [Steps 300-400] media content ['sequence of "moving images"' (See paragraph 0024)] referenced by the second playlist" as claimed.

Referring to claim 2, Otenasek discloses the method for managing streaming media content as claimed. See paragraphs 0013 and 0024 for this disclosure. In particular, Otenasek's step of retrieving media content referenced by the second playlist further comprises: "streaming content referenced by the second playlist [See paragraph 0024 & the discussion of step 400] to a client device [content review/control site 20 & viewer(s) 50-1 – 50-n]" as claimed.

Referring to claim 3, Otenasek discloses the method for managing streaming media content as claimed. See Figures 1 & 2 and the corresponding portions of Otenasek's specification for this disclosure. In particular, Otenasek's method "is performed by a particular computer [Administrator 40]" and the step of retrieving media content referenced by the second playlist further comprises: "rendering/playing the content referenced by the second playlist [See step 200] in a manner that the particular

computer [Administrator 40] itself is a client [40-1 – 40-n (See Fig. 2)] for the content” as claimed.

Referring to claim 4, Otenasek discloses the method for managing streaming media content as claimed. See paragraphs 0024 and 0031 for this disclosure. In particular, Otenasek’s step of forming a second playlist in the canonical format comprises “dynamically generating [digitally encoding the file] a data structure [AVI file] comprising the second playlist [see above], the data structure being used to manage streaming content referenced by the second playlist [definition of an AVI file (RIFF), or any other canonical multimedia file]” as claimed.

Referring to claim 6, Otenasek discloses the method for managing streaming media content as claimed. See paragraphs 0024, 0031-0032 and 0043 for this disclosure. In particular, Otenasek’s method further comprises “dynamically streaming [See paragraph 0024 & the discussion of step 400] a different set of media content [a different file: any other file in the dynamic database] to a client [50-1 – 50-n], the different media content not being represented in the second playlist [content from another AVI file entirely]” as claimed.

Referring to claim 7, Otenasek discloses the method for managing streaming media content as claimed. See paragraph 0031 for this disclosure. In particular, Otenasek’s plurality of translators [encoders] are COM objects as claimed.

Claim 20 is rejected on the same basis as claim 2. See the discussions regarding claims 1-2 above for the details of this disclosure. In particular, Otenasek’s method is implemented on a computer-readable media [on Administrator 40] comprising

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computer executable instructions comprising a playlist server component [40] and a plurality of translator components [see claim 1 above] as claimed.

Claim 21 is rejected on the same basis as claim 3, in light of the basis for claim 20 above. See the discussions regarding claims 1 and 3 above for the details of this disclosure.

Claim 23 is rejected on the same basis as claim 6, in light of the basis for claim 20 above. See the discussions regarding claims 1 and 6 for the details of this disclosure.

Claim 25 is rejected on the same basis as claim 7, in light of the basis for claim 20 above. See the discussions regarding claims 1 and 7 for the details of this disclosure.

Claim 30 is rejected on the same basis as claim 20. See the discussion regarding claim 20 above, as well as Fig. 2 and the corresponding portion of Otenasek's specification for this disclosure.

Claims 31-33 are rejected on the same basis as claims 1-3 respectively. See the discussions regarding claims 1-3 above for the details of this disclosure.

Claim 34 is rejected on the same basis as claim 7, in light of the basis for claim 31 above. See the discussions regarding claims 1 and 7 for the details of this disclosure.

Claim 36 is rejected on the same basis as claim 6, in light of the basis for claim 31 above. See the discussions regarding claims 1 and 6 for the details of this disclosure.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 8-9, 24 and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otenasek in view of U.S. Patent No. 6,564,263 to Bergman et al.

Referring to both claims 8 and 9, Otenasek discloses the method of claim 1 as above, wherein the canonical playlist format is AVI format and an AVI encoder interface is used to create the second playlist. Otenasek does not explicitly teach the use of a SMIL data format and a SMIL interface as claimed. However, Otenasek does state that any common encoding standard could be used in place of AVI. See paragraph 0031 for this disclosure.

Bergman discloses a system and method similar to that of Otenasek, and specifically teaches the commonality of the SMIL data format for use in similar systems. See column 2, lines 37-56 of Bergman's specification for this disclosure. Thus, Bergman teaches that the SMIL data format was a common encoding standard at the time of applicants' invention.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a SMIL interface to create Otenasek's canonical playlists in a SMIL data format as opposed to the AVI format disclosed. One would have been motivated to do so because of Otenasek's direct suggestion shown above.

Claim 24 is rejected on the same basis as claim 8, in light of the basis for claim 20 above. See the discussions regarding claims 1 and 8 for the details of this disclosure.

Claims 38-39 are rejected on the same basis as claims 8-9 respectively, in light of the basis for claim 31 above. See the discussions regarding claims 1 and 8-9 for this disclosure.

8. Claims 5, 10-19, 22, 26-29, 35, 37 and 40-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otenasek in view of U.S. Patent No. 5,974,503 to Venkatesh et al.

Referring to claim 5, Otenasek does not explicitly teach the ability to dynamically interrupt a particular media item as it is being streamed from the second playlist as

claimed. This, however, is only because Otenasek is silent on detailed functionality of the actual streaming process.

Venkatesh discloses a system and method similar to that of Otenasek, wherein the streaming media (audio/video) can be dynamically interrupted for insertion, deletion, or other editing of media items being streamed from a playlist. See Figures 34-37 and the corresponding portions of Venkatesh's specification for this disclosure. In particular, Venkatesh teaches dynamically interrupting [editing break-in] a particular media item [clip] as it is being streamed ['during playback of clips in the playlist... during the streaming of continuous media data' (column 44, lines 44-51)] from a playlist as claimed. Refer specifically to columns 44-48 for the details of this disclosure.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add Venkatesh's dynamic playlist editing functionality to the system and method of Otenasek so as to allow dynamic interruption of a streaming media item for editing of the playlist. One would have been motivated to do so in order to afford the user greater control and functionality in the streaming of media content to a client terminal, as provided by Venkatesh.

Referring to claim 10, the system and method of Otenasek in view of Venkatesh as applied to claim 5 above discloses the invention as claimed. See Figures 34-37 and the corresponding portions of Venkatesh's specification for this disclosure. In particular, Otenasek in view of Venkatesh teaches the method as recited in claim 1, "further comprising:

providing one or more transformers [Venkatesh's dynamic playlist editing functions] that impose respective policies [editing functions] on content referenced by the first playlist; and

notifying [issuance of an edit command] at least one of the one or more transformers to impose a policy [edit function] on the content referenced by the second playlist" as claimed.

Referring to claim 11, the system and method of Otenasek in view of Venkatesh as applied to claim 10 above discloses the invention as claimed. See columns 44-48 of Venkatesh's specification for this disclosure. In particular, Otenasek in view of Venkatesh teaches the method of claim 10, wherein imposing the policy [edit function] results in a modification to the second playlist, the modification being (a) removing a reference [clip] from the second playlist, or (b) adding a reference [clip] to the second playlist as claimed.

Referring to claim 12, the system and method of Otenasek in view of Venkatesh as applied to claim 10 above discloses the invention as claimed. Venkatesh's dynamic playlist editing functions (transformers), as added to the system and method of Otenasek above, are not explicitly disclosed as COM objects as claimed. However, Otenasek's translators/encoders are explicitly disclosed as COM objects. Thus, in adding Venkatesh's dynamic playlist editing functions (transformers) to Otenasek's system as above, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement them as COM objects to obtain the invention

as claimed. One would have been motivated to do so in order to conform to Otenasek's server structure as described above.

Claim 13 is rejected on the same basis as claim 11. See the discussion regarding claim 11 above for the details of this disclosure.

Claim 14 is rejected on the same basis as claim 11, in light of the basis for claim 5 above. See the discussions regarding claims 1, 5 and 10-11 for the details of this disclosure.

Referring to claim 15, the system and method of Otenasek in view of Venkatesh as applied to claim 13 above discloses the invention as claimed. See the discussions above and the relevant portions of both specifications for the details of this disclosure. In particular, Otenasek in view of Venkatesh discloses the method as recited in claim 13, "the operations further comprise:

dynamically interrupting a particular media item as it is being streamed [see discussion of claim 5 above];

streaming another media item [clip added to the playlist]; and

resuming a set of operations specified by the second playlist [continuing regular playback of the playlist after the inserted clip]" as claimed.

Claim 16 is rejected on the same basis as claim 12, in light of the basis for claim 13 above. See the discussions regarding claims 1, 10, 12 and 13 for the details of this disclosure.

Claim 17 is rejected on the same basis as claim 10. See the discussions regarding claims 1 and 10 above for the details of this disclosure.

Claim 18 is rejected on the same basis as claim 11, in light of the basis for claim 10 above. See the discussions regarding claims 1, 10 and 11 for the details of this disclosure.

Claim 19 is rejected on the same basis as claim 17. See the discussion regarding claim 17 above for the details of this disclosure. In particular, the method of Otenasek in view of Venkatesh is implemented on a computer-readable media [on Otenasek's Administrator 40] comprising computer executable instructions as claimed.

Claim 22 is rejected on the same basis as claim 5, in light of the basis for claim 20 above. See the discussions regarding claims 1 and 5 above for the details of this disclosure.

Claim 26 is rejected on the same basis as claim 14, in light of the basis for claim 20 above. See the discussions regarding claims 1 and 14 above for the details of this disclosure.

Referring to claim 27, the system and method of Otenasek in view of Venkatesh as applied to claim 26 above discloses the invention as claimed. See column 44, lines 51-56 of Venkatesh's specification, as well as the portions of Otenasek's specification mentioned above, for the details of this disclosure. In particular, Venkatesh's dynamic playlist editing functions (supervisory component) uses a graphical user interface to visualize and manually manipulate elements [clips] and attributes [headers, etc.] of the canonical playlist as claimed.

Claims 28-29 are rejected on the same basis as claims 10-11, in light of the basis for claim 20 above. See the discussions regarding claims 1 and 10-11 for the details of this disclosure.

Claim 35 is rejected on the same basis as claim 5, in light of the basis for claim 31 above. See the discussions regarding claims 1 and 5 for the details of this disclosure.

Claim 37 is rejected on the same basis as claim 15, in light of the basis for claim 31 above. See the discussions regarding claims 1 and 15 for the details of this disclosure.

Claims 40-44 are rejected on the same basis as claims 10-14 respectively, in light of the basis for claim 31 above. See the discussions regarding claims 1 and 10-14 for the details of this disclosure.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent Nos. 6,553,404 to Stern ; 5,859,660 to Perkins et al ; and 6,581,102 to Amini et al. are each considered pertinent to applicants' claimed invention.

The remaining prior art of record and not relied upon is considered pertinent to applicants' disclosure as well as portions of applicants' claimed invention.


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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Goddard whose telephone number is 703-305-7821. The examiner can normally be reached on M-F, 9 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

bdg
July 23, 2003


WAYNE AMSBURY
PRIMARY PATENT EXAMINER
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